

REMARKS

Claims 1-6 are now pending in the application. Claims 1 and 5 have been currently amended. Pending Claims 1-2 stand rejected under 35 U.S.C. § 102 (b). Pending Claim 3 stand rejected under 35 U.S.C. § 103 (a). The forgoing amendments and following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance. An early Notice of Allowance is therefore requested.

Currently amended Claims 1 and 5 have been amended to include a motor where the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings. Support for this amendment appears for example, in the specification at paragraph [0010]. Accordingly, it is respectfully submitted that no new matter has been added by this amendment.

I. Rejection Of Pending Claims 1 and 2 Under 35 U.S.C. § 102 (b)

The Examiner has rejected Claims 1 and 2 under 35 U.S.C. § 102 (b) as being anticipated by Yang, U.S. Patent No. 5,925,963, issued July 20, 1999 ("Yang"), as applied to currently amended Claim 1. Applicants respectfully traverse this rejection.

A. Relevant Law

"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

B. Summary of Cited References

Yang teaches a low armature reacting magnetic circuit comprised of an integral combination of magnetic circuit structures, one for each magnetic poles including at least the two magnetic field poles of the machine, to achieve magnetic flux circuits of two or more poles within an interference free magnetic flux circuit structure. See Abstract. However, nothing in Yang either teaches or suggests a motor comprising a casing made of a magnetic material for housing a rotor and a coil where side surfaces of the casing have openings that are closed by magnetic plates that are thinner than the thickness of the material of the casing, the part of the magnetic plates facing the side surfaces being flat. Further, nothing in Yang either teaches or suggests that the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings.

C. Argument

The Examiner asserts that Yang teaches a motor for housing a rotor and a stator coil wherein facing side surfaces of the casing have openings that are closed by magnetic plates that are thinner than the thickness of the material of the casing, the part of the magnetic plates facing the side surfaces being flat. The Examiner then concludes that the Yang anticipates the present invention. Applicants respectfully disagree with the Examiner's analysis.

As stated above, currently amended Claim 1 includes a motor where the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings. Yang does not teach or suggest a motor where the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings.

Since Yang does not teach or suggest a motor where the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings, Yang fails to teach or disclose each and every claim element of the claimed invention. Therefore, Yang does not anticipate the present invention. For these reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 (b) are respectfully requested.

II. Rejection Of Pending Claim 3 Under 35 U.S.C. § 103

Claim 3 stand as rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, U.S. Patent No. 5,925,963, issued July 20, 1999 ("Yang"), as applied to currently amended Claim 1. This rejection is traversed and believed overcome in view of the following discussion.

A. Relevant Law

An Examiner may find each claimed element of an invention in the prior art references but it is not sufficient to establish obviousness of the invention. In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). A determination of obviousness must involve more than an indiscriminate combination of the prior art; there must be some motivation, suggestion, or teaching of the desirability of combining or modifying the references to arrive at the claimed method. In re Dance, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). Further, rejecting claims solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed inventions itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention is "an inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 38 USPQ2d 1551 (Fed. Cir. 1996).

B. Summary of Cited References

Yang is discussed above.

C. Argument

The Examiner argues that while Yang does not disclose that the magnetic plate are made of permalloy magnetic material, per se, this would have been obvious to one of ordinary skill since it has been held to be within the general skill of a worker in the art to select a known material such as permalloy on the basis of its suitability for the intended use of a magnetic plate as a matter of obvious design choice. Applicants respectfully disagree with the Examiner's analysis.

Since Claim 3 depends from independent Claim 1, Applicants will address independent Claim 1 first. As discussed above, currently amended Claim 1 includes a motor where the magnetic plates are formed of a magnetic material having better magnetic properties than the

casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings. Yang does not teach or suggest a motor where the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings. Thus, the Applicant believes that the invention is not obvious over the teaching of Yang since Yang does not teach, disclose or suggest the present claims. Moreover, one skilled in the art would find nothing in Yang that would disclose, teach or suggest the claimed invention or any reason for making it.

Applicants also submit that the Examiner has not established a prima facie case of obviousness of Claim 3 under 35 U.S.C. § 103(a). In particular, rejected Claim 3, by virtue of its dependency from Claim 1, is similarly considered by Applicants to patentably define itself over the cited reference.

III. Allowable Subject Matter

Applicants gratefully acknowledge the Examiner notation on page 3 of the Office Action that Claim 4 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicants have currently amended independent Claim 1 to which Claim 4 depends to claim a motor comprising a casing made of a magnetic material for housing a rotor and a coil wherein side surfaces of the casing have openings that are closed by magnetic plates that are thinner than the thickness of the material of the casing, the part of the magnetic plates facing the side surfaces being flat, wherein the magnetic plates are formed of a magnetic material having better magnetic properties than the casing such that the uniformity of the magnetic passage is maintained against the interruption derived from the openings. No new matter has been added by this amendment.

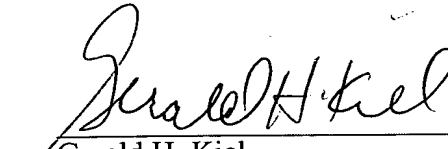
Applicants also thank the Examiner for indicating that Claims 5-6 are allowable.

Serial No.: 10/649,905

VI. Conclusion

For the reasons presented above, Claims 1-6, all the claims pending in the application, are believed by Applicants to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

Respectfully submitted,



Gerald H. Kiel
Reg. No. 25,116

REED SMITH LLP
599 Lexington Avenue
New York, NY 10022
(P) 212-521-5400

Attorney for Applicant